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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,484	01/25/2001	Kehyeh Szutu	SZUTU-2K01	7935

7590

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13445 Mandoli Drive
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EXAMINER

ALI, MOHAMMAD

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

09/771,484

Applicant(s)

SZUTU, KEHYEH

Examiner

Mohammad Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. The application has been examined. Claims 1-16 are pending in this Office Action.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(e), which papers have been placed of the record in the file.

Drawings

3. The drawings filed on June 07, 2001 have been approved by the Draftsperson under 37 CFR 1.84 or 1.152, see attached Form PTO-948.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 16 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending

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Application No. 09/815,642. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations, using varying terminology. Please see explanation below:

The following table shows the claims in 09/771,484 that are rejected by corresponding claims in 09/815,642.

Claims Comparison Table

	09/771,484	09/815,642
Claim	16	16

Certain limitations including 'a unified access', 'unified access code to an e-mail address of Internet user' found in claim of 09/815,642 are not found in claim 16 of this instant application. It would be obvious to a person of ordinary skill in the art at the time the invention was made to exclude the terms 'a unified access', 'unified access code to an e-mail address of Internet user' because the remaining elements would have performed the same function as before. "Omission of element and its function and its function in combination is obvious expedient if the remaining elements perform the same function as before" See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Darin Duphorne ('Duphorne' hereinafter), US Patent 6,212,265 B1.

With respect to claim 1,

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Duphorne discloses method for generating an universal resource locator (URL) for linking an Internet User to a target Web page (see col. 2, lines 18-29). Duphorne teaches 'said Internet user providing an user-input Internet-independent unique identifier related to said target Web page to a control Web site' as a subscriber having the telephone number (214) 123 -4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. When email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number subscribes to the email notification service, see col. 10, lines 59-66, Duphorne). Finally, Duphorne teaches 'said control Web site searches a database to find an URL corresponding to an Internet-independent unique identifier for generating said URL for linking said Internet user to said target Web page' as when email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number subscribes to the email notification service. If so, the email server sends a callerID-compatilbe email notification signal to the user via the local loop of the public switched telephone network and the notification signal could have all or a predetermined portion of the text of email messages stored on the email server, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne).

As to claim 2,

Duphorne teaches 'said Internet user providing a user-input Internet-independent unique identifier is a step a1) of said Internet user providing said user-input Internet-

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independent unique identifier as a first sub-field following an Internet domain name of said control Web site' as (e MailDestination@DomainName) a subscriber having the telephone number (214) 123 –4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, see col. 10, lines 57-62.

As to claim 3,

Duphorne teaches 'said step b) further comprising a step b1) of said control Web site converting said user-input Internet-independent unique identifier to a normalized Internet-Independent unique identifier of said target Web page for said control Web site to search a database to find an URL corresponding to said normalized Internet-independent unique identifier for generating said URL for linking said Internet user to said target Web page' as a subscriber having the telephone number (214) 123 –4567 and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. The telephone number 214123567 is a normalization form of telephone number of (214) 123 –4567, see col. 10, lines 57 to col. 11, lines 2.

As to claim 4,

Duphorne teaches 'said step a) of said Internet user providing a user-input Internet-independent unique identifier is a step a2) of said Internet user providing said user-input Internet-independent unique identifier as a telephone number corresponding to said target Web page' as receive the email message from the email server through as telephone number email address, see col. 10, lines 59 to col. 11, lines 10.

As to claim 5,

Duphorne teaches 'said step a2) of said Internet user providing said user-input Internet-independent unique identifier as a telephone number corresponding to said target Web page is a step a3) of inputting said telephone number as a first sub-field following an Internet domain name of said control Web site' as (e-MailDestination@DomainName) a subscriber having the telephone number (214) 123 – 4567 and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com "destination address", see col. 10, lines 59-62.

As to claim 6,

Duphorne teaches 'said step a) of said Internet user providing a user-input Internet-independent unique identifier is a step a4) of said Internet user providing said user-input Internet-independent unique identifier as a advertisement identifier number corresponding to said target Web page' as a subscriber having the telephone number (214) 123 –4567 "unique identifier as an advertisment" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, see col. 10, lines 59-62.

As to claim 7,

Duphorne teaches 'said step a4) of said Internet user providing said user-input Internet-independent unique identifier as an advertisement identifier number corresponding to said target Web page is a step a5) of inputting said advertisement identifier number as a first sub-field following an Internet domain name of said control

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Web site' as the serve name is the Internet address or fully qualified domain name operated by the telco or other service provide. A subscriber having the telephone number (214) 123 –4567 and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, "destination address", see col. 10, lines 56-62.

As to claim 8,

Duphorne teaches 'said step a) of said Internet user providing a user-input Internet-independent unique identifier is a step a6) of said Internet user providing said user-input Internet-independent unique identifier as a branch location name corresponding to said target Web page' as a subscriber having the telephone number (214) 123 –4567 "unique identifier as a branch" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, see col. 10, lines 59-62.

As to claim 9,

Duphorne teaches 'said step a6) of said Internet user providing said user-input Internet-independent unique identifier as an branch location name corresponding to said target Web page is a step a7) of inputting said branch location name as a first sub-field following an Internet domain name of said control Web site' as a subscriber having the telephone number (214) 123 –4567 and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, see col. 10, lines 59-62.

With respect to claim 16,

Duphorne teaches network system (see col. 2, lines 18-29). Duphorne teaches 'a network resource management center provided with an interactive database for enabling an owner of a network resource to editing an unique linking pointer for linking to said network resource' (a subscriber having the telephone number (214) 123 -4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. When email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number subscribes to the email notification service, see col. 10, lines 59-66, Duphorne).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darin Duphorne ('Duphorne' hereinafter), US Patent 6,212,265 B1 in view of Paarsmarkt et al ('Paarsamrkt' hereinafter), US Patent 6,118,856.

With respect to claim 10,

Duphorne discloses a network system (see col. 2, lines 18-29). Duphorne teaches 'a network resource management center comprising a database for storing a network-independent preexisting-unique identifier to a network resource locator' as (when email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number "preexisting-unique identifier" subscribes to the email notification service. If so, the email server sends a callerID-compatible email notification signal to the user via the local loop of the public switched telephone network and the notification signal could have all or a predetermined portion of the text of email messages stored on the email server, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne.

Duphorne does not explicitly indicate the claimed "paired data linking".

Paarsmarkt discloses the claimed step of paired data linking (a communications "linking" port for signaling a remote device and forwarding at least a portion of the email to remote device, see col. 7, lines 4-6, Fig. 1, Paarsmarkt).

It would have been obvious to one ordinary skill in the data processing art, at the time of the present invention to combine the teachings of the cited references, because paired data linking of Paarsmarkt's teachings would have allowed Duphorne's system to forward an email in response to at least a portion of the email when a predetermined portion of the email matches pre-specified conditions with sender identification, as suggested by Paarsmarkt, at col. 2, lines 48-54. Paired data linking as taught by Paarsmarkt improves a telephone apparatus having a receiver for receiving an email

and a processor circuit having a communications port, for automatically forwarding at least a portion of the email from the communications port to remote device, in response to receiving the email (see col. 2, lines 54-58, Paarsmarkt).

As to claim 11,

Duphorne teaches 'said network resource management center further comprising a network-resource request-input processor for processing a network-resource request input comprising information related to said network-independent preexisting-unique identifier for searching said database for providing a linked URL stored in said database' as a subscriber having the telephone number (214) 123 -4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. When email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number subscribes to the email notification service, see col. 10, lines 59-66, Duphorne.

As to claim 12,

Duphorne teaches 'said network resource management center further comprising a network-resource registration processor for receiving a registration request comprising a network-independent preexisting-unique identifier and an associated network resource locator for storing in said database' as when email server receives the email message, the email server access "registration" an associated lookup table or database to confirm that the user identified by the telephone number "preexisting-unique identifier" subscribes to the email notification service. If so, the email server sends a

callerID-compatible email "forward" notification signal to the user via the local loop of the public switched telephone network and the notification signal could have all or a predetermined portion of the text of email messages stored on the email server, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne.

As to claim 13,

Duphorne teaches 'said network-resource request-input processor further comprising a network-resource request-input normalizing means for normalizing and converting a network-resource request-input into a normalized network-resource request' as a subscriber having the telephone number (214) 123 -4567 and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com. The telephone number 214123567 is a normalized form of telephone number of (214) 123 -4567, see col. 10, lines 57 to col. 11, lines 2.

As to claim 14,

Duphorne teaches 'said network-resource request-input processor further comprising a first sub-domain processing means for receiving and processing a network-resource request-input constituting a first sub-domain name under an Internet domain name of said network resource management center' as a subscriber having the telephone number (214) 123 -4567 "unique identifier" and having an email server having the Internet address of mailservice.com is alerted by sending an email message addressed to 2141234567@mailservic.com, see col. 10, lines 57-62.

As to claim 15,

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Duphorne teaches 'an universal resource locator forward means for forwarding an universal resource locator retrieved from said database to a network resource Requester' as when email server receives the email message, the email server access an associated lookup table or database to confirm that the user identified by the telephone number "preexisting-unique identifier" subscribes to the email notification service. If so, the email server sends a callerID-compatible email "forward" notification signal to the user via the local loop of the public switched telephone network and the notification signal could have all or a predetermined portion of the text of email messages stored on the email server, see col. 10, lines 62 to col. 11, lines 10 and Fig.1, Duphorne.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Ali whose telephone number is (703) 605-4356. The examiner can normally be reached on Monday to Thursday from 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790 or Customer Service (703) 306-5631. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for any communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Mohammad Ali
Patent Examiner
AU 2177


MA

November 25, 2003


JEAN P. HOMERE
PRIMARY EXAMINER